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10/034,511	12/28/2001	Jitendra Patel	J6743(C)	1274

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UNILEVER
PATENT DEPARTMENT
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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,511

Applicant(s)

PATEL ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claims 1-40 are pending in this application.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of improper format. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

2 Claim 2 objected to because of the following informalities:

Claim 2 objected to because the words in the lines of the claim are crowded too closely together or improperly spaced, making reading and entry of amendments difficult. Appropriate correction is required.

Claim 2, also objected to because the terms "N, N-bis (hydroxyethyl)-2,4-diaminophenol" on page 46, line 24 and "2,4-diamino-5-methylphenol" page 46, lines 27-28 are misspelled. Appropriate correction is required.

The examiner makes of record that instant claims 5 and 6 recite a broad range of components followed by a series of narrow ranges. For examination purposes, the examiner

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asserts that the narrow ranges recited in the instant claims 5 and 6 are merely exemplary ranges, and thus, the prior art will be applied against the broadest ranges recited in the instant claims 5 and 6. Further, the examiner suggests that applicant should delete the narrow ranges from the instant claims 5 and 6, and add new dependent claims that recite the narrow ranges recited in the instant claims 5 and 6.

Claim 35 objected to because the claim recites the imitation "part ai and part ai " wherein the second "part ai " should be changed to "part aii ". Correction is required to make the claim clear and more definite.

Furthermore, the examiner makes of record that instant claim 40 recites a number of selected alcohols followed by the term "the like". For examination purposes, the examiner asserts that the term "the like" merely exemplary fatty alcohols, and thus, the prior art will be applied for any fatty alcohol.

Claim Rejections - 35 USC § 112

3 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 39 is indefinites because the claim recites the limitation "A composition according to claim 35" in line 1. There is insufficient antecedent basis for this limitation in the claim, because claim 35 drawn to a dispenser (apparatus) and not drawn to a composition.

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Claim 40 is indefinites because the claim recites the limitation "A composition according to claim 35" in line 1. There is insufficient antecedent basis for this limitation in the claim, because claim 35 drawn to a dispenser (apparatus) and not drawn to a composition.

Double Patenting

4 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 13-40 provisionally rejected under the judicially created doctrine of double patenting over claims 1-34 of co-pending Application No. 10/034174, claims 1-23 of co-pending Application No. 10/096812, claims 1-26 of co-pending Application No. 10/095657 and claims 1-2 and 4-28 of co-pending Application No. 10/196130. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on these co-pending applications since the referenced co-pending applications and the instant application are claiming common subject matter, as follows: All claims are drawn to the similar methods for permanently dyeing hair using similar steps for applying similar mixture compositions of oxidative dye intermediates in a shampoo base at alkaline pH and oxidative compound in a shampoo base at

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acidic pH and wherein all sets of the claims recite similar conditioning agents presented in the compositions. The claims are differ only in that the instant claims require at least one of part ai or part aii has about 0.01 to about 5.0% of a conditioning agent and at least one of part ai and aii optionally has about 0.01 to about 10.0% of a structurant.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply such a method for dyeing hair by incorporating a dye composition that may comprise conditioning agents or structurant components because the co-pending applications teach similar methods for dyeing hair wherein the methods comprise the steps of applying to the hair dyeing compositions that comprise conditioning agents such as fatty alcohols (structurants) (co-pending application No. 10/034174), conditioner bases (surfactants) and fatty alcohols (co-pending application No. 10/196130), conditioning agents (fatty alcohols) (co-pending application No. 10/095657) and conditioning agent of gelling agent (fatty alcohol) (co-pending application No. 10/096812) thus, a person of the ordinary skill in the art would be motivated to select and choose fatty alcohols (structurants), surfactants (conditioner bases) or gelling agents (fatty alcohols) as a conditioning agent as taught by the co-pending applications and would expect such a method to have similar results to those claimed, absent, unexpected results.

Claim Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casperson et al. (US 5,376,146) in view of Lapidus et al. (US 4,104,021).

Casperson (US' 146) teaches a method for dyeing hair. The method comprises the step of contacting the hair with a mixture of a two part aqueous composition of a) an alkaline aqueous lotion having a pH of from about 7 to about 11 which within the claimed range as claimed in claim 3 (see col. 3, 50-52) containing from about 0.005% by weight to about 5% by weight (equimolar quantities of oxidation bases and couplers) of at least one primary intermediate such as para-phenylenediamine, from 0.005% to about 5% by weight of at least one coupler for the formation of oxidation dyes as claimed in claims 1, 2, 5, 33 and 34 (see col. 8, lines 30-34), from about 0.1% to about 5% of a quaternary ammonium compound (conditioner agent) and at least 70% by weight water and may be as higher as 95% or higher to make the lotion (shampoo base) in an aqueous condition which falls within the claimed ranges as claimed in claims 5, 6 and 27 (see col. 3, lines 50-53 and col. 4, lines 3-4), and b) an aqueous developer (oxidizing agent) having a pH of from about 2.5 to 4.5 which is overlapped with the claimed range as claimed in claim 4 and containing from about 0.5% by weight to about 40% of a peroxide oxidizer such as hydrogen peroxide as claimed in claim 26 (col. 3, lines 57-62, col. 9, lines 52-53 and claim 9). At the end of the coloring period the composition is washed from the hair with ordinary water as claimed in claim 37 (see col. 10, lines 64-66 and col. 11, lines 20-24). Casperson also teaches a method for dyeing hair comprising the dyeing composition as described above, wherein the viscosity of the dyeing composition is from 1 cps to about 5000 cps by weight which overlaps with the claimed range as claimed in claim 28 (see col. 10, lines 35-37). Casperson further, teaches a method for dyeing hair comprising applying to the hair the dyeing composition as

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described above, which may be separately provided and ready for mixing by the finger manipulation (hand) as claimed in claim 36 to initiate the dyeing process (see col. 10, lines 67-68 and col. 11, lines 1-4 and lines 29-35).

The instant claims differ from the reference by reciting a method for dyeing hair comprising applying to the hair a dyeing composition for a number of treatments having a set time interval of about 8 hours and 30 days between each two consecutive such treatment as claimed. Further, the reference fails to teach the period for contacting hair between ½ minute and two minutes as claimed in claim 7 and the time interval of 1 day and 3 days as claimed in claim 8. Furthermore, the reference does not teach or disclose the physical properties of the hair such as highlighted, yield stress index, combing force, combing index, minimize hair outgrowth, delta E and IR absorption and break stress as claimed in claims 9-25 and 29-31.

Lapidus (US' 021) in analogous art of hair dyeing processes, teaches a process for dyeing hair comprising applying to the hair a mixture of a colorant-oxidative solution in successive applications for a time period up to 5 minutes and of substantially the same length for each subsequent application and wherein the application can be repeated once every 2 to 8 weeks (see col. 4, lines 45-63 and col. 7, claim 1).

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the primary reference by incorporating the process for dyeing hair that involves successive applications to the hair as taught by Lapidus with reasonable expectation of success because Lapidus clearly teaches that dyeing hair with successive applications of dyeing composition in a short time period provided a deeper shades (see col. 2, lines 65-68 and col. 3, lines 1-4), and, thus, a person of ordinary skill

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in the art would be motivated to apply the dyeing composition with a successive applications to obtain a deeper shades of color and would expect such a process to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to contact the hair with the dyeing composition for a period of the claimed time because Lapidus teaches the application for a time period up to 5 minutes, which is a very short time period by conventional dyeing standard as taught by the reference (see col. 4, lines 47-49) and wherein the time period range is overlapping with the claimed range, and, thus, a person of the ordinary skill in the art would expect such a method to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claim 8, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply to the hair the dyeing composition in a number of treatments with the claimed time interval because Lapidus teaches that the desired interval, determined by the user (see col. 4, lines 51-52), and thus, a person of the ordinary skill in the art would be motivated to determine the time interval between each two consecutive treatments includes those claimed, and would expect such a method to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claims 9-25 and 29-31, it would have been obvious to one having ordinary skill in the art at the time the invention was made to calculate physical properties similar to those claimed, because the combined references teaches a hair dyeing compositions comprising similar dyeing ingredients with similar concentrations wherein the compositions applied with similar process of successive application, and, thus, a person of ordinary skill in the

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art would expect such a process to have similar properties and similar results to those claimed, absent unexpected results.

6 Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casperson et al. (US 5,376,146) in view of Lapidus et al. (US 4,104,021) and further in view of Boulton, Wade (EP 1 289 712).

The disclosures of Casperson (US' 146) and Lapidus (US' 021) are summarized above. The references fail to teach a dispenser for dispensing simultaneously part ai and aii in a method for dyeing hair as claimed in claim 35.

However, the primary reference of Casperson teaches a dyeing composition provided in a kit or package form ready for mixing by the user, either professional or personal, to initiate the dyeing process (see col. 10, lines 67-68 and col. 11, lines 1-2).

Boulton (EP' 712) in analogous art of hair dyeing formulations, teaches a package adapted for the dispensing of a hair dye composition which package comprises a container with means to maintain two compositions A and B, therein isolated from each other. The composition (A) comprises oxidation bases and an alkaline substance adapted to produce a pH in the range of 8.5 to 10.0, oleic acid and ethoxylated (25) lanolin alcohol as conditioner agents and the composition (B) comprises an oxidizing agent of hydrogen peroxide and cetyl alcohol as a conditioner agent, and valve means communicating with each of the compositions whereby the application of pressure to the compositions and actuation of the valve means results in the mixing of portions of each of the compositions and dispersing of the resulting mixture from the package as a hair dye composition (see page 5, Example 1 and page 7, claims 1 and 2). Further, the reference teaches a dispenser comprising valve means to communicate individually with the two compositions, the

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valve means being constructed such that actuation causes flow of composition A and composition B in the relative proportions of 1:1 (see page 5, Example 1).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to use such a dispenser in a process for dyeing hair with a reasonable expectation of success because the primary reference of Casperson teaches a hair dyeing composition provided in kit or package form ready for mixing by the user, either professional or personal, to initiate the dyeing process (see col. 10, lines 67-68 and col. 11, lines 1-2), and, thus, a person of the ordinary skill in the art would be motivated to use the dispenser for dyeing hair with a reasonable expectation of success to obtain a homogenous and well mixed dyeing composition, absent unexpected results.

7 Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffer et al. (US 2003/0028979).

Duffer (US' 979 A1) teaches a hair dyeing composition comprising a dye mixture and a developer mixture (see page 1, paragraph 0025). The dye mixture comprises 0.63% of dye intermediate such as p-phenylenediamine, alkalizing agent such as ammonium hydroxide in the amount of 27.5% , about 0.4% of Oley alcohol as a conditioner (see page 10, Examples 1 and 2) and volatile silicone of cyclomethicone in the amount of 0.01 to 4% which is overlapped with the claimed range (see page 5, paragraph 0077 and page 6, paragraph 0087). The developer mixture comprises hydrogen peroxide as an oxidizing agent in the amount of 4% which is within the claimed range (see page 13, claim 1). The composition also comprises anionic surfactant as claimed in claim 39 and fatty alcohol such as Oleyl alcohol as claimed in claim 40 (see page 10, Example 1).

The claims differ from the reference by reciting 1 to 99% of a shampoo base to presented in part aii.

However, the reference teaches a developer composition (oxidizing composition) comprising 0.03% of disodium phosphate as an alkaline base (see page 10, Example 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a composition by optimizing the amount of the aqueous base in the developer composition with a reasonable expectation of success because the reference clearly teaches the presence of disodium phosphate as a base in the oxidizing composition, and, thus a person of the ordinary skill in the art would be motivated to optimized the amount of the base in the composition so as to get the maximum effective amount and would expect such a composition to have similar properties to those claimed, absent unexpected results.

Conclusion

The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "Eisa Elhilo".

Eisa Elhilo
Patent Examiner
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August 7, 2003